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To: Commissioner for Patents for **Examiner John M. Winter** **Group Art Unit 3621**	Facsimile No.: **703/872-9306**
From: Jennifer Pilcher Legal Assistant to Wayne Bailey	No. of Pages Including Cover Sheet: **5**
Message: Transmitted herewith: • Transmittal Document; and • Reply Brief.	
Re: Application No. **09/877,157** Attorney Docket No: **RSW920000172US1**	
Date: Tuesday, June 28, 2005	
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Bleizeffer et al.**

Serial No.: **09/877,157**

Filed: **June 8, 2001**

For: **Interface for Creating Privacy Policies for the P3P Specificiation**

§ Group Art Unit: **3621**
§
§ Examiner: **Winter, John M.**
§
§ Attorney Docket No.: **RSW920000172US1**
§

36736
PATENT TRADEMARK OFFICE
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By: Jennifer Pilcher
Jennifer Pilcher

TRANSMITTAL DOCUMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:
ENCLOSED HEREWITH:

- Reply Brief (37 C.F.R. 41.41).

No fees are believed to be required. If, however, any fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0461. No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0461.

Respectfully submitted,

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Docket No. RSW920000172US1

PATENT

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By: Jennifer Pilcher
Jennifer Pilcher

REPLY BRIEF (37 C.F.R. 41.41)

This Reply Brief is submitted in response to the Examiner's Answer mailed on May 3, 2005.

No fees are believed to be required to file a Reply Brief. Any required petition for extension of time for filing this brief and fees therefore, are dealt with in the accompanying TRANSMITTAL OF REPLY BRIEF.

ARGUMENT

A. Grouping of Claims

On page 2 of the Examiner's Answer, the Examiner states "The Appellant's brief includes a statement that the claims stand or fall together". Appellants urge that this statement is incorrect, and Appellants have separately argued the following groupings of claims in the originally filed appeal brief:

Claims 1, 12 and 24 (separately argued under heading B.1)
Claims 4 and 15 (separately argued under heading B.2)
Claims 5 and 16 (separately argued under heading B.3)
Claims 6, 7, 17 and 18 (separately argued under heading B.4)
Claims 10 and 21 (separately argued under heading B.5)
Claims 11 and 22 (separately argued under heading B.6)
Claim 23 (separately argued under heading B.7)

B. 35 U.S.C. 101 Rejection

In rationalizing the rejection of Claim 1, the Examiner states "This process might be performed without the aid of any technology and therefore the claimed method is not within the technological arts". Appellants respectfully submit that Claim 1 specifically recites a technological aid – specifically a data processing apparatus – that is used to implement each of the claimed steps, and thus the claimed method is within the technological arts. Claim 1 explicitly recites:

> "A *data processing apparatus-implemented method* for creating a privacy policy, comprising *data processing apparatus-implemented steps of*: creating a policy group; moving a data element to the policy group; and generating a privacy policy based on the policy group" (emphasis added by Appellants)

C. **35 U.S.C. 103 Rejection**

Claims 1, 12 and 24

In the Response to Argument section in the Examiner's Answer, under the heading "Second Issue" on page 8, the Examiner characterizes Appellants' arguments as being *nonanalogous art* with respect to the two cited references. To the contrary, Appellants have argued that the Examiner has failed to properly establish a *prima facie showing of obviousness*, and has not argued that the cited references are nonanalogous.

Claims 6, 7, 17 and 18

In the Response to Argument section in the Examiner's Answer, under the heading "Second Issue" on page 8, the Examiner contends that the Applicant has made no formal challenge to the Official Notice taken in the prior rejections. Appellants urge that they in fact did make a formal challenge to the Examiner's position, and traversed the Examiner's position by stating that whether or not something is "well-known" is not a proper basis for an obviousness rejection. As recently articulated by the Federal Circuit in *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.* (Fed Circuit Opinion 04-1493 dated June 9, 2005), inventions are typically new combinations of existing principals, and the invention should be considered as a whole and not broken down into component parts (each of which may be individually known). The Examiner did not consider the inventions of Claims 6, 7, 17 and 18 as a whole, but instead broke such claims into component pieces and alleged that such component pieces were well-known, which is error.

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